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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/552,131

**Applicant(s)**

MELKOTE ET AL.

**Examiner**

ANH LY

**Art Unit**

2162

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

#### **DETAILED ACTION**

1. This Office Action is response to Applicants' AMENDMENT filed 03/27/2008.
2. Claims 1-41 are pending in this Application.

#### ***Response to Arguments***

3. Applicant's arguments filed 03/27/2008 have been fully considered but they are not persuasive.

Applicant argued that, "filing date of TRAN appears to be MAY 1, 2000, after the filing date of the instant application." (page 9, the 3<sup>rd</sup> paragraph, in the remarks).

Examiner respectfully disagrees as argued. In response to Applicants' arguments: On the front page of TRAN's publication No.: US 2002/0095368 A1 printed that this is Non-provisional application No. 60/200,962, filed on May, 1, 2000, which is a non-provisional of provisional application No. 60/185,644, filed on **Feb. 29, 2000**. Thus, It is **before** the filing data of the instant application (04/19/2000).

The specification and drawings of 60/185,644 described: Intellectual Property, On-line or electronic form, online communications (figs. 1, 2A, 3B-3D, page 7, lines 12-16). It had the same as TRAN's invention disclosure.

Applicant argued that, "Anecki does not disclose allowing access to various users comprising at least one inventor of said invention disclosure for reviewing the

information.” (page 9, the 4<sup>th</sup> paragraph, page 11, the 1<sup>st</sup> paragraph, page 14, 2<sup>nd</sup> paragraph, in the remarks).

In response to Appellants' arguments, Examiner respectfully disagrees as Anecki teaches users may access and control the legal document creation and approval process (page 3, paragraphs 0046, lines 1-5 and 0047, lines 2-6). Legal document is a kind of IP document, from which the user granted access or allowed access and controlled its status such as approval of status of a legal document; tracking of legal documents once the legal documents are issued to the customer or client or inventor (page 3, paragraph 0047, lines 1-6).

Applicant argued that, “Anecki does not disclose prompting the user for classification information ....” (page 11, the 2nd paragraph, in the remarks).

In response to Appellants' arguments, Examiner respectfully disagrees as Anecki teaches when the forms popped up or prompted to the users, the receiver may select the filter button to enter the field or data into the field with technical data (page 9, paragraphs 0122-0123 and 0108).

Applicant argued that, “Anecki does not disclose selecting an evaluator based on the classification information.” (page 12, the 2nd paragraph, in the remarks).

In response to Appellants' arguments, Examiner respectfully disagrees as Anecki teaches evaluating the information and approving the legal document (page 6, paragraph 0092).

Applicant argued that, "Anecki does not disclose allowing access to said disclosure after storing the plurality of disclosure information within said database and prompting said ... for invention disclosure approval." (page 12, the 5<sup>th</sup>, paragraph, in the remarks).

In response to Appellants' arguments, Examiner respectfully disagrees as Anecki teaches users may access and control the legal document creation and approval process (page 3, paragraphs 0046, lines 1-5 and 0047, lines 2-6). Legal document is a kind of IP document, from which the user granted access or allowed access and controlled its status such as approval of status of a legal document; tracking of legal documents once the legal documents are issued to the customer or client or inventor (page 3, paragraph 0047, lines 1-6) and when the forms popped up or prompted to the users, the receiver may select the filter button to enter the field or data into the field with technical data (page 9, paragraphs 0122-0123 and 0108).

Applicant argued that, "TRAN does not disclose prompting the user for classification information ..." (page 12, the last, paragraph, in the remarks).

In response to Appellants' arguments, Examiner respectfully disagrees as TRAN teaches the server supports an IP portal that provides a single point of integration, access and navigation thru the systems. The user interface allows a user to login or logoff the system with his/her own password that accepted by the system and some technical information (technical of the invention and categorization): (page 2, 0016, page 3, 0019 and page 6, 0043).

Applicant argued that, "TRAN does not disclose coupling said user information with said invention disclosure." (page 14, 3rd, paragraph, in the remarks).

In response to Appellants' arguments, Examiner respectfully disagrees as TRAN teaches the server supports an IP portal that provides a single point of integration, access and navigation thru the systems. The user interface allows a user to login or logoff the system with his/her own password that accepted by the system and some technical information (technical of the invention and categorization): page 2, 0016, page 3, 0019 and page 6, 0043) and user's profile containing user information (page 2, 0010, lines 5-20 and page 4, 0024-0025).

Applicant argued that, "Anecki does not disclose performing a search to determine the state of the art associated ... at least one inventor of said invention disclosure." (page 14, 4<sup>th</sup>, paragraph, in the remarks).

In response to Appellants' arguments, Examiner respectfully disagrees as Anecki teaches searching form as shown in figs. 22-23 and search results form the searching database having legal documents or IPs (page 9, 0120-0123).

For the above reasons, Examiner believed that rejection of the last Office action was proper.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-16, 17-20, 22, 23-36 and 37-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pub. No.: US 2002/0095368 A1 of TRAN (Non-provisional of provisional application No. 60/185,644, filed on Feb. 29, 2000) in view of Pub. No.: US 2006/0010377 A1 of Anecki et al. (hereinafter Anecki) (provisional application No.: 60/187,444, filed on Mar. 7, 2000) and further in view of Pub. No.: US 2001/0049707 A1 of TRAN (hereinafter TRAN707) (Non-provisional of provisional application No. 60/185,644, filed on Feb. 29, 2000).

With respect to claim 1, TRAN teaches a method of forming an invention disclosure (forming legal document on Web-based system for Intellectual Property (IP): abstract, sections 0016-0017 and 0020-0022), comprises the step of:

after each of the plurality of selected information portions are entered, storing each of the information portions in a central storage location (via web-based interface, the user enters information/data on on-line form and it is stored on a database stored on the server as shown in fig. 1: sections 0014-0015 and abstract).

TRAN teaches on-line form via web-based interface for user to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig.

1. TRAN does not explicitly teach allowing access to various users comprising at least one inventor of said invention disclosure for reviewing the information and allowing online access to the status of invention disclosure, said status comprising said invention disclosure is in a reviewing and application filing process as claimed.

However, Anecki teaches reviewing legal document and access and approve status of a legal document (sections 0046-0047; also see sections 0052-0053 and 0059). Also, users may access and control the legal document creation and approval process (page 3, paragraphs 0046, lines 1-5 and 0047, lines 2-6). Legal document is a kind of IP document, from which the user granted access or allowed access and controlled its status such as approval of status of a legal document; tracking of legal documents once the legal documents are issued to the customer or client or inventor (page 3, paragraph 0047, lines 1-6).



Therefore, based on TRAN in view of Anecki, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of TRAN with the teachings of Anecki. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (Anecki's abstract and sections 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (Anecki's sections 0001 and 0010-0011). Combination of TRAN and Anecki do not teach forming an invention disclosure online by entering a plurality of selected information portions into a web-based system.

However, TRAN707 teaches generating a patent application or intellectual property or invention disclosure over internet or on-line via prompting from which a user enable to enter an invention disclosure and assist the user in discerning validity and patentability of subject matter (paragraphs 0041 and 0044).

Therefore, based on TRAN in view of Anecki, and further in view of TRAN707, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of TRAN707 to the system of TRAN to generate an invention disclosure online from the user as disclosed (TRAN707's paragraph 0041), into the system of TRAN for the purpose of procuring intellectual property assets,

thereby, enabling user to locate and navigate the information needed to procure IP assets (TRAN707's paragraphs 0002 and 0015).

With respect to claim 2, TRAN teaches wherein said step of forming includes providing identification information; whereby upon providing identification information to said web-based server, retrieving user information from the directory system in response to the identification information (identification information to the user and searching information: sections 0026 and 0029).

With respect to claims 3 and 8, TRAN teaches a method as discussed in claim 1.

TRAN teaches on-line form via web-based interface for user to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig. 1. TRAN does not explicitly teach comprising the step of prompting the user for classification information classifying the invention disclosure into a technology area as claimed.

However, Anecki teaches filtering information via a "Filter" button as shown on fig. 21 (sections 0122-0123 and 0128); and when the forms popped up or prompted to the users, the receiver may select the filter button to enter the field or data into the field with technical data (page 9, paragraphs 0122-0123 and 0108).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of Anecki. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention

disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (Anecki's abstract and sections 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (Anecki's sections 0001 and 0010-0011).

With respect to claims 4-7, TRAN teaches a method as discussed in claim 1. Also, TRAN teaches evaluation process for an IP asset (sections 0042-0043).

TRAN teaches on-line form via web-based interface for user to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig.

1. TRAN does not explicitly teach notifying an evaluator in response to the classification information prompting an evaluation from the evaluator, notifying an evaluator comprises generating an e-mail; providing hyperlink to the disclosure in the e-mail; scheduling an evaluation meeting and ranking the disclosure as claimed.

However, Anecki teaches evaluating the information and approving the legal document (section 0092); generating email and hyperlink (sections 0009, 0041, 0051-0052 and 0062, fig. 8); scheduling and ranking (sections 0002 and 0122-0123 and 0128).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of Anecki. One having ordinary skill in the art would have found it motivated to utilize the

use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (Anecki's abstract and sections 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (Anecki's sections 0001 and 0010-0011).

With respect to claims 8-9, TRAN teaches notifying a patent staff in response to the classification information and prompting a patentability review from the patent staff person (sections 0009-0010 and fig. 1).

With respect to claims 10-12, TRAN teaches a method as discussed in claim 1.

TRAN teaches on-line form via web-based interface for user to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig. 1. TRAN does not explicitly teach wherein said central location comprises a database coupled to a web server, identifying co-authors; notifying co-authors of a disclosure with their name associated therewith in the system and notifying comprises the step of generating an E-mail having a hyperlink therein as claimed.

However, Anecki teaches web server as shown in figs. 8 and 10 (sections 0095 and 0101-0102) and generating email and hyperlink (sections 0009, 0041, 0051-0052 and 0062, fig. 8).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of Anecki. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (Anecki's abstract and sections 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (Anecki's sections 0001 and 0010-0011).

With respect to claims 13-14, TRAN teaches a method as discussed in claim 1. Also, TRAN teaches evaluation process for an IP asset (sections 0042-0043).

TRAN teaches on-line form via web-based interface for user to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig. 1. TRAN does not explicitly teach wherein said central location comprises a database coupled to a web server, identifying co-authors; notifying co-authors of a disclosure with their name associated therewith in the system and notifying comprises the step of generating an E-mail having a hyperlink therein as claimed.

However, Anecki teaches email and hyperlink (sections 0009, 0041, 0051-0052 and 0062, fig. 8).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of Anecki. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (Anecki's abstract and sections 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (Anecki's sections 0001 and 0010-0011).

With respect to claims 15 and 16, TRAN teaches prompting users for a password and scanning said paper submission into the database (entering user name and password and submitting the form storing in the patent database: sections 0005, 0007, 0017, 0024 and 0026).

With respect to claim 17, TRAN teaches an invention disclosed system (fig. 1), comprising:

- at least one user computer accessible by a plurality of inventors associated with a single invention disclosure (fig. 1);

- a server coupled to said at least one user computer (fig. 1);

- a database coupled to the server (fig. 1);

- and said server providing user screen to said least one user computer to prompt said inventors to provide a plurality of disclosure information to said server, after storing

the plurality of disclosure information within said database (fig. 1, user interface is web-based user interface and system prompts for user to enter information to the system: sections 0014, 0016-0018).

TRAN teaches on-line form via web-based interface for user to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig.

1. TRAN does not explicitly teach prompting said plurality of inventors for invention disclosure approval as claimed.

However, Anecki teaches reviewing legal document and access and approve status of a legal document (sections 0046-0047; also see sections 0052-0053 and 0059); users may access and control the legal document creation and approval process (page 3, paragraphs 0046, lines 1-5 and 0047, lines 2-6). Legal document is a kind of IP document, from which the user granted access or allowed access and controlled its status such as approval of status of a legal document; tracking of legal documents once the legal documents are issued to the customer or client or inventor (page 3, paragraph 0047, lines 1-6) and when the forms popped up or prompted to the users, the receiver may select the filter button to enter the field or data into the field with technical data (page 9, paragraphs 0122-0123 and 0108).

Therefore, based on TRAN in view of Anecki, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of TRAN with the teachings of Anecki. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and

tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (Anecki's abstract and sections 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (Anecki's sections 0001 and 0010-0011). Combination of TRAN and Anecki do not teach receiving the plurality of disclosure information from said users, storing information in said database after each of the plurality of disclosure information is entered, allowing access to said disclosure.

However, TRAN707 teaches generating a patent application or intellectual property or invention disclosure over internet or on-line via prompting from which a user enable to enter an invention disclosure and assist the user in discerning validity and patentability of subject matter (paragraphs 0041 and 0044).

Therefore, based on TRAN in view of Anecki, and further in view of TRAN707, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of TRAN707 to the system of TRAN to generate an invention disclosure online from the user as disclosed (TRAN707's paragraph 0041), into the system of TRAN for the purpose of procuring intellectual property assets, thereby, enabling user to locate and navigate the information needed to procure IP assets (TRAN707's paragraphs 0002 and 0015).

With respect to claim 18, TRAN teaches comprising a directory system coupled to said server whereby upon proving identification information to sever said server



retrieves user information from the directory system in response to the identification information (identification information to the user and searching information and user has to sign-in/sign-off the system: sections 0016-0018 and 0026 and 0029).

With respect to claim 19, TRAN teaches wherein said server comprises a web server (a web server: fig. 8 and 10, sections 0095 and 0101-0102).

With respect to claim 20, TRAN teaches wherein said user computer comprises a web browser for accessing said server (using a browser for viewing: sections 0008 and 0027).

With respect to claim 22, TRAN teaches wherein server comprises a web single login to access said invention disclosure (sign-on and password: sections 0016 and 0023-0024).

With respect to claim 23, TRAN teaches a method of forming an invention disclosure (forming legal document on Web-based system for Intellectual Property (IP): abstract, sections 0016-0017 and 0020-0022) comprising:

after each of the plurality of selected information portions are entered, storing each of the information portions in a central storage location (via web-based interface, the user enters information/data on on-line form and it is stored on a database stored on the server as shown in fig. 1: sections 0014-0015 and abstract) and

prompting the user for classification information, which refers to a technology area (technical of the invention and categorization: sections 0019 and 0043).

TRAN teaches on-line form via web-based interface for user to enter information related to IP document or application and store those information or data into a

database in the central location of a web server of a web-based system as shown in fig.

1. TRAN does not explicitly teach allowing access to various users to access the information; notifying an evaluator in response to the classification information and prompting an evaluation from evaluator as claimed.

However, Anecki teaches reviewing legal document and access and approve status of a legal document (sections 0046-0047; also see sections 0052-0053 and 0059) and evaluating the information and approving the legal document (section 0092) and users may access and control the legal document creation and approval process (page 3, paragraphs 0046, lines 1-5 and 0047, lines 2-6). Legal document is a kind of IP document, from which the user granted access or allowed access and controlled its status such as approval of status of a legal document; tracking of legal documents once the legal documents are issued to the customer or client or inventor (page 3, paragraph 0047, lines 1-6).

Therefore, based on TRAN in view of Anecki, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of TRAN with the teachings of Anecki. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (Anecki's abstract and sections 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using

computerized processing (Anecki's sections 0001 and 0010-0011). Combination of TRAN and Anecki do not teach forming an invention disclosure online by entering a plurality of selected information portions into a web-based system.

However, TRAN707 teaches generating a patent application or intellectual property or invention disclosure over internet or on-line via prompting from which a user enable to enter an invention disclosure and assist the user in discerning validity and patentability of subject matter (paragraphs 0041 and 0044).

Therefore, based on TRAN in view of Anecki, and further in view of TRAN707, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of TRAN707 to the system of TRAN to generate an invention disclosure online from the user as disclosed (TRAN707's paragraph 0041), into the system of TRAN for the purpose of procuring intellectual property assets, thereby, enabling user to locate and navigate the information needed to procure IP assets (TRAN707's paragraphs 0002 and 0015).

With respect to claim 24, TRAN teaches wherein said step of forming includes providing identification information; whereby upon providing identification information to said web-based server, retrieving user information from the directory system in response to the identification information (identification information to the user and searching information: sections 0026 and 0029).

With respect to claims 25-27, TRAN teaches a method as discussed in claim 23.

TRAN teaches on-line form via web-based interface for user to enter information related to IP document or application and store those information or data into a

database in the central location of a web server of a web-based system as shown in fig.

1. TRAN does not explicitly teach notifying an evaluator comprises generating an e-mail; providing hyperlink to the disclosure in the e-mail; scheduling an evaluation meeting and ranking the disclosure as claimed.

However, Anecki teaches generating email and hyperlink (sections 0009, 0041, 0051-0052 and 0062, fig. 8); scheduling and ranking (sections 0002 and 0122-0123 and 0128).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of Anecki. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (Anecki's abstract and sections 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (Anecki's sections 0001 and 0010-0011).

With respect to claims 28-29, TRAN teaches notifying a patent staff in response to the classification information and prompting a patentability review from the patent staff person (sections 0009-0010 and fig. 1).

With respect to claims 30-32, TRAN teaches a method as discussed in claim 23.

TRAN teaches on-line form via web-based interface for user to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig.

1. TRAN does not explicitly teach wherein said central location comprises a database coupled to a web server, identifying co-authors; notifying co-authors of a disclosure with their name associated therewith in the system and notifying comprises the step of generating an E-mail having a hyperlink therein as claimed.

However, Anecki teaches web server as shown in figs. 8 and 10 (sections 0095 and 0101-0102) and generating email and hyperlink (sections 0009, 0041, 0051-0052 and 0062, fig. 8).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of Anecki. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (Anecki's abstract and sections 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (Anecki's sections 0001 and 0010-0011).

With respect to claims 33-34, TRAN teaches a method as discussed in claim 23. Also, TRAN teaches evaluation process for an IP asset (sections 0042-0043).

TRAN teaches on-line form via web-based interface for user to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig.

1. TRAN does not explicitly teach wherein said central location comprises a database coupled to a web server, identifying co-authors; notifying co-authors of a disclosure with their name associated therewith in the system and notifying comprises the step of generating an E-mail having a hyperlink therein as claimed.

However, Anecki teaches email and hyperlink (sections 0009, 0041, 0051-0052 and 0062, fig. 8).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of Anecki. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (Anecki's abstract and sections 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (Anecki's sections 0001 and 0010-0011).

With respect to claims 35 and 36, TRAN teaches prompting users for a password and scanning said paper submission into the database (entering user name and

password and submitting the form storing in the patent database: sections 0005, 0007, 0017, 0024 and 0026).

With respect to claim 37, TRAN teaches a method of submitting documents (submitting IP document: sections 0017), comprising:

entering identification information into a user computer (sign-on with user name/user ID and password: sections 0016 and 0024-0026); and

coupling said user information with said invention disclosure (user information: sections 0016, 0023-0024 and 0034; the server supports an IP portal that provides a single point of integration, access and navigation thru the systems. The user interface allows a user to login or logoff the system with his/her own password that accepted by the system and some technical information (technical of the invention and categorization): page 2, 0016, page 3, 0019 and page 6, 0043) and user's profile containing user information (page 2, 0010, lines 5-20 and page 4, 0024-0025).

TRAN teaches on-line form via web-based interface for user to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig. 1. TRAN does not explicitly teach retrieving user information from a directory system in response to said identification information, storing the disclosure in a computer database, performing a search is at least the state of art associated with said invention disclosure and wherein said search is at least partially directed by at least one inventor of said invention disclosure as claimed.

However, Anecki teaches searching/retrieving legal documents (sections 0040 and 0060), storing legal document in the legal document database (section 0050) and performing search the legal documents or prior arts (see fig. 1 and section 0041) and searching form as shown in figs. 22-23 and search results form the searching database having legal documents or IPs (page 9, 0120-0123).

Therefore, based on TRAN in view of Anecki, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of TRAN with the teachings of Anecki. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (Anecki's abstract and sections 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (Anecki's sections 0001 and 0010-0011). Combination of TRAN and Anecki do not teach entering disclosure information to create an invention disclosure.

However, TRAN707 teaches generating a patent application or intellectual property or invention disclosure over internet or on-line via prompting from which a user enable to enter an invention disclosure and assist the user in discerning validity and patentability of subject matter (paragraphs 0041 and 0044).



Therefore, based on TRAN in view of Anecki, and further in view of TRAN707, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of TRAN707 to the system of TRAN to generate an invention disclosure online from the user as disclosed (TRAN707's paragraph 0041), into the system of TRAN for the purpose of procuring intellectual property assets, thereby, enabling user to locate and navigate the information needed to procure IP assets (TRAN707's paragraphs 0002 and 0015).

With respect to claims 38-39, TRAN teaches a method as discussed in claim 37.

TRAN teaches on-line form via web-based interface for user to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig.

1. TRAN does not explicitly teach prompting the user for classification information, notifying an evaluator in response to the classification information prompting an evaluation from the evaluator as claimed.

However, Anecki teaches filtering information via a "Filter" button as shown on fig. 21 (sections 0122-0123 and 0128) and evaluating the information and approving the legal document (section 0092).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of Anecki. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure,

reviewing and filing a patent application (Anecki's abstract and sections 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (Anecki's sections 0001 and 0010-0011).

With respect to claims 40-41, TRAN teaches notifying a patent staff in response to the classification information and prompting a patentability review from the patent staff person (sections 0009-0010 and fig. 1).

6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pub. No.: US 2002/0095368 A1 of TRAN (provisional application No. 60/185,644, filed on Feb. 29, 2000) in view of Pub. No.: US 2006/0010377 A1 of Anecki et al. (hereinafter Anecki) (provisional application No.: 60/187,444, filed on Mar. 7, 2000), and further in view of Pub. No.: US 2006/0190443 A1 of Mathews et al. (hereinafter Mathews) (continuation of application No.: 09/539,500, filed on Mar. 30, 2000).

With respect to claim 21, TRAN view of Anecki discloses an invention disclosure system as discussed in claim 17.

TRAN and Anecki disclose substantially the invention as claimed.

TRAN and Anecki do not explicitly teach comprises a computer aided design (CAD) file view coupled to said web browser as claimed.

However, Mathews teaches using CAD and CAD facility for viewer (section 0054; also see sections 0051-0054).

Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify TRAN and Anecki's system to include CAD facility for viewer as taught by Mathews in order for providing a way to view the legal document or IP. The motivation being for providing access to drawing information and distribution of design drawing data, thereby, viewing the information or files over the Internet using a browser (Mathews's section 0007 and 0020).

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### **Contact Information**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANH LY whose telephone number is (571) 272-4039 or via E-Mail: [ANH.LY@USPTO.GOV](mailto:ANH.LY@USPTO.GOV) (Written Authorization being given by Applicant (MPEP 502.03 [R-2])) or fax to **(571) 273-4039** (unofficial fax number directly to examiner's office). The examiner can normally be reached on TUESDAY – THURSDAY from 8:30 AM – 3:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **John Breene**, can be reached on **(571) 272-4107** or Primary Examiner, **Jean Fleurantin**, can be reached on **(571) 272-4035**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any response to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, or faxed to: **Central Fax Center: (571) 273-8300**.

ANH LY /AL/

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